

REMARKS

By this Amendment, Applicants amend claims 1, 2, 4-8, and 14, and cancel claim 3 without prejudice or disclaimer of the subject matter thereof. Claims 1, 2, and 4-14 are pending in the application.

Applicants wish to thank the Examiner for discussing the prior Office Action with Applicants' undersigned representative during a telephone interview held on January 26, 2005. During that interview, the prior Office Action and rejection of claims 1-14 under 35 U.S.C. §102(e) as anticipated by Suzuki (U.S. Patent No. 6,129,274) were discussed.

In the Final Office Action,¹ the Examiner rejected claims 1-14 under 35 U.S.C. § 102(e) as anticipated by Kolls (U.S. Patent No. 6,601,038). Applicants respectfully traverse the rejection, and note that the rejection with respect to canceled claim 3 is moot. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 1 recites a “method of providing advertisements to an automated service machine over a network” including, among other steps, “selecting, from the server coupled to the network, an advertisement based upon the consumer history of the user.” Kolls does not disclose at least this element of claim 1.

In the Final Office Action, the Examiner alleges “Kolls teaches ... selecting from a server coupled to the network an advertisement based upon the information identifying the user.” See Final Office Action, page 2. Applicants note that the Kolls system discloses “[t]he selection of marketing advertisements can be ... in accordance with a customer profile (individual or by group type).” See col. 32, lines 25-27. Further, according to Kolls, “[a]n individual customer profile is a profile for an individual person” and a “group profile is ... specific to a group.” See col. 32, lines 30-32. However, use of the customer profile taught by Kolls does not constitute a teaching of “selecting ... an advertisement based upon the *consumer history* of the user,” (emphasis added) as recited in claim 1. Since Kolls does not teach each and every element of claim 1, Kolls does not anticipate claim 1. The Examiner should thus withdraw the rejection of claim 1 under 35 U.S.C. § 102(e).

Independent claims 7, 8, and 14, while of a different scope from claim 1 and from each other, include recitations similar to those discussed above with regard to claim 1. Accordingly, Kolls does not anticipate claims 7, 8, and 14 for at least the same reason discussed above in connection with claim 1. The Examiner should therefore withdraw the rejection of claims 7, 8, and 14 under 35 U.S.C. § 102(e).

Claims 2 and 4-6 depend from claim 1 and claims 9-13 depend from claim 8. Accordingly, Kolls does not anticipate claims 2, 4-6, and 9-13 at least due to their

dependence from claim 1 and the Examiner should thus withdraw the rejection of the claims under 35 U.S.C. § 102(e).

Moreover, claim 2 further recites "selecting the advertisement based on the consumer history of the user and the location of the automated service machine." Kolls also does not disclose at least this element of claim 2. The Examiner should therefore withdraw the rejection of claim 2 for at least this additional reason.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 26, 2005

By: Anthony J. Lombardi
Anthony J. Lombardi
Reg. No. 53,232